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| 10/669,578 | 09/23/2003 | Jeffrey A. Kusnitz | RSW920030150US1 (283) | 5640 |
| 46320 7590 08/06/2008 CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP STEVEN M. GREENBERG 950 PENINSULA CORPORATE CIRCLE SUITE 3020 BOCA RATON, FL 33487 | | | | |
| EXAMINER | | | | |
| ADDY, THUAN KNOWLIN | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2614 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/669,578

Applicant(s)

KUSNITZ ET AL.

Examiner

THJUAN K. ADDY

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 33-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on May 06, 2008 has been entered. No claims have been amended. Claims 25-32 have been cancelled. No claims have been added. Claims 1-24 and 33-35 are still pending in this application, with claims 1, 9, 17, and 33 being independent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6, 8-14, 16-22, 24, 33, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoakum et al. (US Patent Application, Pub. No.: US 2004/0059781 A1).
3. In regards to claims 1, 9, 17, and 33, Yoakum discloses a telephone (See Fig. 1 and packet-based telephony device/packet telephone system 32), method, computer storage medium, and wireless telephone system having a first connection to a packet switched network (See Fig. 1 and packet-switched network 12) comprising apparatus

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for storing multiple identifications (e.g., telephone 16A, mobile terminal 16B, office telephone, and/or home telephone) of one or more entities (e.g., individual(s)) selectable by a user (e.g., subscriber) of the telephone that can be called from the telephone, apparatus for storing one or more telephone numbers (e.g., numbers for telephone 16A, mobile telephone 16B, office telephone, and/or home telephone) associated with each entity, apparatus for receiving from the packet switched network (See Fig. 1 and packet-switched network 12) presence indicators (e.g., presence information or state information) associated with some of the telephone numbers (See pg. 3, paragraph [0026]; pg. 3, paragraph [0029]; and pg. 4, paragraph [0032]), a memory (See Fig. 1 and presence system 20) for storing the presence indicators in association with their corresponding telephone numbers (See pg. 2, paragraph [0018]; pg. 2, paragraph [0021]; and pg. 3, paragraph [0027]), and apparatus responsive to a selection of an entity by a user for selecting a number for dialing based on the state of the presence indicators associated with the selected entity (See pg. 3, paragraph [0027]; pg. 4, paragraph [0034] - [0035]; and pg. 4, paragraph [0038] - [0041]).

4. In regards to claims 2, 10, and 18, Yoakum discloses the telephone, method, and computer storage medium, having apparatus for placing calls over a circuit-switched telephone network (See Fig. 1 and circuit-switched network 10) and apparatus for placing calls over the packet-switched network (See Fig. 1 and packet-switched network 12) (See pg. 2, paragraph [0019]).

5. In regards to claims 3, 11, and 19, Yoakum discloses the telephone, method, and computer storage medium, wherein the telephone comprises a base station (See Fig. 7

and subscriber/base station interface 70) having connections to the circuit-switched network and to the packet-switched network and a mobile device (See Fig. 1 and mobile telephone 16B) that communicates with the base station using wireless protocols (See pg. 2, paragraph [0019] and pg. 8, paragraph [0071]).

6. In regards to claims 4, 12, 20, and 34, Yoakum discloses the telephone, method, computer storage medium, and system, wherein the base station contains the apparatus for storing the identifications of entities, the telephone numbers (e.g., numbers for telephone 16A, mobile terminal 16B, office telephone, and/or home telephone) associated with the entities (e.g., individual(s)) and the presence indicators (e.g., presence information or state information), and the mobile device comprises a memory (See Fig. 1 and presence system 20) for storing the name of the entities, means allowing a user to select an entity for dialing, and means for transmitting a name of a selected entity to the base station (See pg. 1-2, paragraph [0016]).

7. In regards to claims 5, 13, and 21, Yoakum discloses the telephone, method, and computer storage medium, wherein the base station further comprises an apparatus for routing a call to the circuit-switched network or to the packet-switched network according to a user preference associated with the selected number (See pg. 2, paragraph [0019] and pg. 8, paragraph [0071]).

8. In regards to claims 6, 14, and 22, Yoakum discloses the telephone, method, and computer storage medium, wherein the base station further comprises a memory for storing user routing preferences based on time-of-day (See pg. 5, paragraph [0044]).

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9. In regards to claims 8, 16, and 24, Yoakum discloses the telephone, method, and computer storage medium, further comprising apparatus responsive to an unanswered telephone call for determining if additional numbers are stored for the called entity and re-trying a call to such an additional telephone number (See pg. 4, paragraph [0034] – [0040]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7, 15, 23, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoakum et al. (US Patent Application, Pub. No.: US 2004/0059781 A1).

11. In regards to claims 7, 15, and 23, Yoakum discloses the telephone, method, computer storage medium, wherein the base station further comprises a memory for storing user routing preferences based on time-of-day (See pg. 5, paragraph [0044]). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to incorporate a memory for storing user routing preference based on an area code of the selected number, thus allowing a user to store his or her preferences based on the area code of the individual.

12. In regards to claim 35, Yoakum discloses all of claim 35 limitations, except the system, wherein an identification stored in the handset is a company name. Yoakum, however, does disclose numerous individuals identified in a contact list (See pg. 1-2, paragraph [0016]). Therefore, it would have been obvious to incorporate the individual as being a company.

Response to Arguments

13. Applicant's arguments with respect to claims 1-24 and 33-35 have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments are moot, due to the fact that the "telephone" recited in independent claims 1, 9, 17, and 33 is now being read as packet-based telephony device/packet telephone system 32 (See Fig. 1 and pg. 3, paragraph [0027]).

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to THJUAN K. ADDY whose telephone number is (571)272-7486. The examiner can normally be reached on Mon-Fri 8:30-5:00pm.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (571) 272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thjuan K. Addy/
Primary Examiner, Art Unit 2614